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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,312	05/06/2002	Karin Briner	X-12592	5925

25885 7590 07/14/2004

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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,312

Applicant(s)

BRINER ET AL.

Examiner

Emily Bernhardt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicants' response filed 4/30/03 the following still applies.

Receipt of an Abstract is acknowledged. However it should be resubmitted on a **separate page** so that it can be separately indexed and thus seen by the printer if the case is ever allowed. The case is in electronic form.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,11-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hartog (EP'612). Cancelling method claims directed to depression, one of the uses described by Hartog among many others, does not overcome the rejection for instant compounds, composition claims. The fact that Hartog does not teach 5-HT_{2c} activity is irrelevant. Note In re Shetty 195 USPQ 753 and In re Dillon 16 USPQ 2d 1897. The discovery of an additional property does not make otherwise obvious compounds unobvious. Applicant must prove that their compound(s) possess a property that the prior art compound(s) do not possess- not is not disclosed to possess. See In re Best 195 USPQ 430; In re Dillon 16 USPQ 2d 1897.

Claims 1,2,4,7,9-17 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S.

Patent '936 for reasons of record. Note that avoidance of literal overlap is not enough to preclude an obviousness-type double patenting rejection. See MPEP 804, section on "Obvious-type". If it was, then one wouldn't ever need to make such a rejection employing a secondary reference as an ancillary teaching, which is certainly permitted. The test is whether the claims in the 2nd case are merely an obvious variation of an invention already claimed in another patent- that is, "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C.103" as stated in MPEP 804, p.800-22, left column, August 2001 Ed. The close structural similarity previously pointed out by the examiner renders the instant claims indistinct from those in US'936. The motivation to make instant claimed compounds comes from the close structural similarity as shown in the case law previously cited. In all of these decisions there was no express teaching to arrive at the compounds on appeal yet claims were refused based solely on the close structural relationship that existed with the prior art and thus the examiner is not relying on anything more than the claims of US'936 in making the rejection. This rationale is consistent with the MPEP section dealing with obviousness involving close structural similarity such as homologs, analogs and isomers. See MPEP 2144.09. Also note the following quote taken from *Rafac v. Matsushita* 17 USPQ 2d 1293: "Obviousness-type double patenting voids a subsequently issued patent

for a "mere variation of that [previous] invention which would have been obvious to those of ordinary skill in the relevant art." . Also note In re Bowers 149 USPQ 573 which involved H vs Me- substituted steroids. See particularly pages 572-573 in which following the Board's decision a petition for rehearing was granted and a terminal disclaimer filed and ultimately approved which was deemed sufficient to obviate the claims of the commonly assigned patent before the CCPA.

Applicants' additional argument of identical patent term if present case is allowed with that of ~~patent~~ patent ignores the requirement of common assignment which a terminal disclaimer always includes as a contingency of enforceability for any patent granted on an application. See MPEP 1490, page 1400-79, Rev. August 2001. This is to preclude the issuance of 2 patents to the "same" invention ("same" being defined in MPEP 2301.02 as anticipated under 102 or obvious under 103) to different conflicting parties. Compounds such as H vs Me analogs as herein, which would have been rejected under 103 based on the ample case law previously cited if the US Patent was a competent reference, are properly rejected on the grounds of obviousness type double patenting. This is consistent with case law such as Bowers and the MPEP. Applicants urge small differences such as methylation are expected to result in presumably distinct compounds but such an assertion is made without any underlying basis of facts and is not consistent with

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the many compounds claimed herein which are more similar to US'936 than they in turn are to each other. Additionally, obviousness only requires a reasonable expectation of success not absolute predictability as set forth in *In re O'Farrell* 7 USPQ 2d 1673. Thus a terminal disclaimer is needed to overcome this rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is (571) 272-0664.

If attempts to reach the examiner by phone are unsuccessful, the supervisor for AU 1624, Dr. Mukund Shah, can be reached at (571)272-0674.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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E Bernhardt
EMILY BERNHARDT

PRIMARY EXAMINER

Group 1600